

US Serial No.: 10/755,524

Remarks/Arguments

Claims 1-4, 8-15 and 17-24 are pending. The specification is amended to correct a typographical error made upon conversion to this non-provisional application. Support for this amendment is found in the "as filed" provisional application, at page 5, line 16. Claims 1, 8, 11, 12, 15, 21 and 24 are amended as noted above. Support for these amendments is found in the application (and provisional application also for that matter) and claims as filed, and only the amendments to claims 1 and 15 are made to more particularly point out and define the subject invention to overcome cited art of record. No new matter is believed added by any of the amendments made here. Reconsideration and allowance of this application is requested in view of the amendments above and remarks below.

Oath/Declaration

The oath or declaration is not believed to be defective, because a signed and dated Declaration was submitted upon filing, and included therewith was an application data per 37 CFR 1.76. As evidence of these submissions, enclosed are copies of the filed papers along with a copy of the postcard showing receipt of the same by the Patent Office. Accordingly, this objection is respectfully requested to be withdrawn.

Claim Rejections - 35 USC 112

Claim 19 has been rejected under 35 USC 112, first paragraph. This rejection is respectfully traversed because Applicant asserts there is sufficient teaching in the specification, and supporting drawings, to enable the claim for one of ordinary skill in the art. Reference is made to the specification at page 5, lines 22-32, as well as a mark up of FIG 1 herewith. Identified as "A" in FIG. 1, there is seen the "the at least two orifices comprise at least four orifices". Then, identified as "B" in FIG. 1, there is seen the "one pair of orifices is located on opposite sides of one of the at least two openings and midway between opposite ends of the one opening". Finally, identified as "C" in FIG. 1, there is seen the "second pair of orifices is located on opposite sides of a different opening of the at least two openings and midway between a first end of the one opening

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and a second end of the different opening". Accordingly, this rejection is respectfully requested to be withdrawn.

Claims 21-24 have been rejected under 35 USC 112, second paragraph. This rejection is respectfully traversed because Applicant asserts having such process claims depend from product claims is proper, as recognized in the MPEP, at Section 608.01(n), part III. Infringement Test, see attached. Accordingly, this rejection is respectfully requested to be withdrawn.

Claims 21 and 24 have also been rejected under 35 USC 112, second paragraph. This rejection is respectfully traversed because Applicant has amended the claims to have proper antecedent basis, and such amending does not in any way narrow the scope of these claims as filed. Accordingly, this rejection is respectfully requested to be withdrawn.

Claims 9-12 have been rejected under 35 USC 112, second paragraph. This rejection is respectfully traversed because Applicant has amended the claims to have proper antecedent basis, and such amending does not in any way narrow the scope of these claims as filed. Accordingly, this rejection is respectfully requested to be withdrawn.

Claim Rejection – 35 USC 102

Claims 1-14 has been rejected under 35 USC 102(b) as being anticipated by *Miller* (US 4,289,290). This rejection is traversed as moot, insofar as it even applies to the now presented claims. It is well established under the patent laws that there can be no anticipation unless (1) all the same elements are (2) found in exactly the same situation and (3) are united in the same way to (4) perform the identical function.

Particularly, neither *Miller*, alone or in combination with any of the patents of record (assuming such a combination is proper, which Applicant assert is not proper based on the teaching in *Miller* and the other art of record), teaches or suggests the now recited combination of features of Applicant's invention, which includes *inter alia*: a [a] rectangular plate; at least two openings in the plate, each opening wholly contained within the front and back faces so as to not intersect with the side edges, and the at least two openings comprise slots and [b] the slots have a length extending parallel to the

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length direction of the plate and [c] the slots are each located on a center axis of the plate relative to the length direction of the plate; and, at least one pair of orifices in the plate, the pair of orifices located adjacent opposite side edges of the plate along the length of the plate so as to form a weakened zone widthwise for bending the plate along the weakened zone.

For at least the features [a], [b] and [c] noted above, *Miller* lacks such elements, and in fact, based on the teachings of *Miller*, one of ordinary skill in the art would not be properly motivated to modify *Miller* to obtain Applicant's now recited invention. *Miller* is not a rectangular plate, as it requires all parts 24a-24e plus back panel 26 in order to achieve its desired functions. Rather, *Miller* is a T-shaped plate, which is much different than Applicant's invention. In this regard then, the length direction of the plate in *Miller* runs parallel to panel 26. Only slots 36a in the center of member 24 are slots and oriented in a length direction of the *Miller* plate. These slots do not intersect the axis which is parallel to panel 26. Holes 36b intersect the axis, but they are holes and not slots. Still further, not only does *Miller* lack at least these feature, but insofar as *Miller* does include slots and orifices, they are united in a different way and they achieve a much different bracket structure. Accordingly, for at least these reasons *Miller* cannot (and does not) anticipate Applicant's recited invention. Thus, the rejection of claim 1, as well as dependent claims 2-14 for at least the same reasons, based upon *Miller* is respectfully requested to be withdrawn.

For clarification, it is noted that the amendment to the independent claims to recite "the slots are each located on a center axis of the plate relative to the length direction of the plate" (emphasis added) means that a portion of the slots intersect a portion of the center axis, e.g., axis line 38-38 in FIG. 5. As such, these so located slots could be perfectly aligned along the line 38-38 as seen in FIG. 5, or askew left or right of line 38-38 (not specifically shown) as long as a portion of the slots intersects the center axis. In a similar regard, Applicant asserts that the definition of intersect noted in the Office Action at page 5, "(intersect by definition 'meaning sharing a common area')" is not within the scope of the teaching of the subject invention per the specification and drawings. Rather, as used in the specification, drawings and claims, for an orifice, opening or edge to intersect, they must do more than simply share a "common area", such

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as 24a or 24b in FIG. 1 of *Miller*, they must run into each other so as to share a common edge, boundary or circumference. If "intersect" as used in the application was so broad as to simply mean "sharing a common area" then all of the openings, orifices and sides of the invention intersect each other because they are all located in the same front (and back) face of the plate 20. Clearly, this is not what Applicant intends nor how one of ordinary skill in the art would understand Applicant's use of "intersect" in the application.

Further in this regard then, the features recited in claims 9 and 11 relating to intersecting notches, side edges and openings are clearly absent from *Miller*. For at least these additional reasons *Miller* cannot (and does not) anticipate Applicant's recited invention in claims 9 and 11.

Additionally, claim 14 (as better now understood based on the above discussion under 35 USC 112) recites a combination of orientations for the orifices and openings that is clearly absent from *Miller*. For at least these additional reasons *Miller* cannot (and does not) anticipate Applicant's recited invention in claim 14.

Claim Rejection – 35 USC 103

Claims 15-24 has been rejected under 35 USC 103(a) as being obvious over *Miller* (US 4,289,290) in view of *Olson* (US 2,638,643). This rejection is traversed as moot, insofar as it even applies to the now presented claims.

Based on the pending rejections in the Office Action, the Patent Office recognizes that *Miller alone* cannot anticipate or render obvious Applicant's invention recited in claims 15-24 before the present amendments. With the present amendments, this is even more so the case now, and also in light of the above discussion regarding *Miller*. *Olson*, does not compensate for the deficiencies noted above in *Miller*, even assuming that *Miller* and *Olson* can be combined as suggest, which Applicant asserts is not a proper combination. As now recited, Applicant's invention is a rectangular plate, and this orientation further dictates how its openings (slots) and orifices are particularly located and oriented, and for the openings they are on a center axis of the plate relative to the length direction of the plate, all which is much different than anything taught in *Miller* or *Olson*, for similar reasons noted in the detailed discussion for *Miller* above.

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Moreover, to modify the structure of *Miller* to include the slots of *Olson* would be contrary to the teachings in *Miller* which has all of its orifices wholly contained within the circumference of the *Miller* plate and not intersecting the side edges. Such a proposed combination of features by chance thrown together from these two references is not supported by any proper teaching, suggestion or incentive in the record, and rather is only possible with impermissible hindsight reconstruction using Applicant's application as a template for doing so. Further, to make such a combination and so modify *Miller* would not likely be met with a reasonable likelihood of success, absent a complete redesign of *Miller* and significant experimentation and analysis to determine if the so modified structure can still perform its desired functions.

In summary, *Miller* and *Olson* cannot be properly combined to render obvious Applicant's presently recited invention, and even if so combined, the combination still fails to teach or suggest features of Applicant's presently recited invention. Accordingly, for at least these reasons the rejection of claim 15, as well as dependent claims 16-24 for at least the same reasons, based upon *Miller* in view of *Olson* is respectfully requested to be withdrawn.

Additionally, claim 19 (as better now understood based on the above discussion under 35 USC 112) recites a combination of orientations for the orifices and openings that is clearly absent from *Miller* and *Olson*. For at least these additional reasons neither *Miller* nor *Olson*, nor or their improper combination, can (or do) render obvious Applicant's recited invention in claim 19.

Still further, claims 21-24 recite features that are absent from *Miller* and *Olson*, and such would be contrary their teachings. For at least these additional reasons neither *Miller* nor *Olson*, nor or their improper combination, can (or do) render obvious Applicant's recited invention in claims 21-24.

In conclusion, Applicant respectfully submits that the objections and rejections to the application have been accommodated, traversed and/or rendered moot. Accordingly, the application is believed to be in condition for allowance and such action is requested in due course.

If there are any questions or a need for clarification on a point, the Examiner is

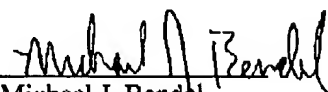
US Serial No.: 10/755,524

invited to contact the undersigned by telephone or other convenient means to try and quickly resolve the same.

Respectfully submitted,

JOHN F. BENTLY

Dated: August 29, 2005

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Applicant: John F. Burtly
 Title: Vent Cover Bracket and Process Therewith
 Claim Priority of 60/451445

Enclosures: Utility Patent Appl. Transmittal (1p.),
 including all returned thereon, including
 Fee (US for 421), Fee Transmittal (1+ copy),
 Specification (13 p.), Drawings (2 p.), New
 Del. for App. (1p.), Application Data Sheet (2 p.),
 Power of Att. (1p.), Prior Art Ref., Non-Patent Literature (1p.).

Express Mail #: ER 892 875 717 US Mailed: Jan 12, 04

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PTO/SB/D1A (00-03)

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**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76)**

Title of Invention	Vent Cover Bracket and Process Therewith
As the below named Inventor(s), I/we declare that:	
This declaration is directed to:	
<input checked="" type="checkbox"/> The attached application, or <input type="checkbox"/> Application No. _____, filed on _____ <input type="checkbox"/> as amended on _____ (if applicable);	
I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;	
I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;	
I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.	
All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.	

FULL NAME OF INVENTOR(S)

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Date:	12-10-03		
Inventor two:			
Signature:		Citizen of:	
Inventor three:			
Signature:		Citizen of:	
Inventor four:			
Signature:		Citizen of:	

☐ Additional inventors or a legal representative are being named on _____ additional form(s) attached hereto.

This collection of information is required by 35 U.S.C. 116 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 minute to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application Information

Application Type:: Regular
Subject Matter:: Utility
Title:: Vent Cover Bracket and Process Therewith
Request for non-Publication?: Yes
Suggest Drawing Figure:: 1
Total Drawing Sheets:: 2
Small Entity: Yes

Applicant Information

Applicant Authority type:: Inventor
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Initial 01/12/04

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Representative Information

Representative	Registration Number::	Name::
Designation::		
Primary	39,605	Michael J. Bendel, Esq.

Domestic Priority Information

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This application	An application claiming the benefit under 35 USC 119(e)	60/451445	03/03/03

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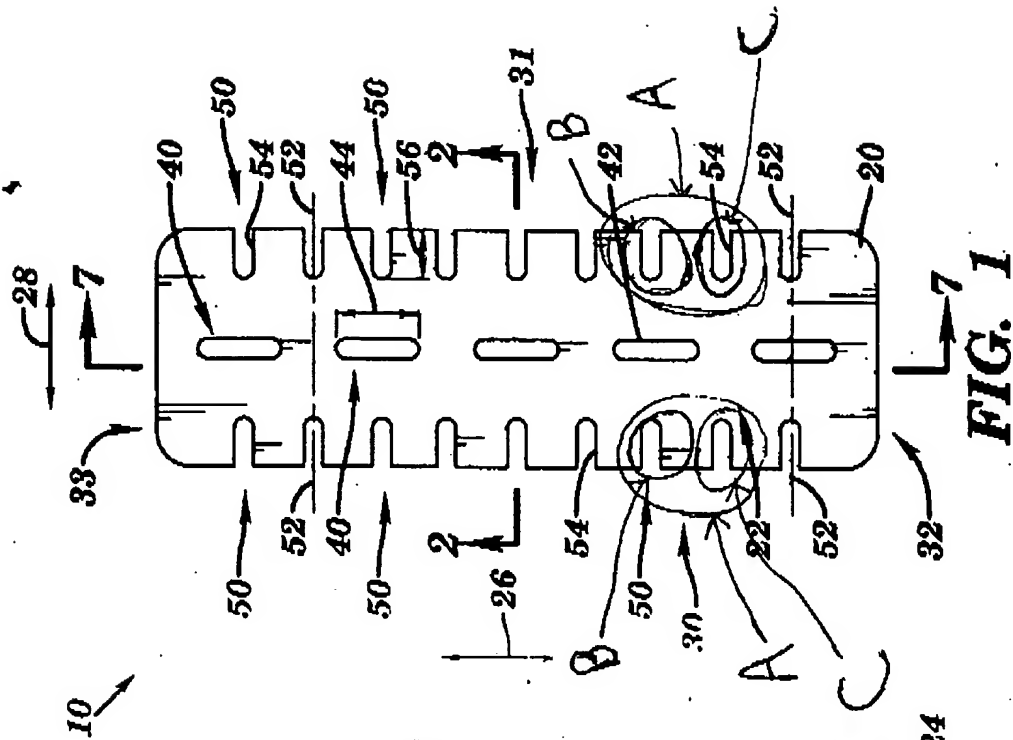


FIG. 1

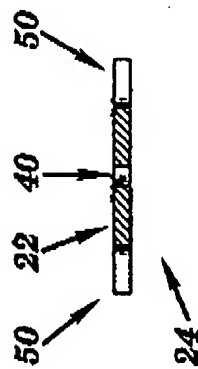


FIG. 2

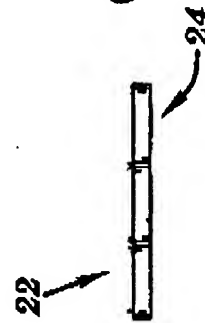


FIG. 3

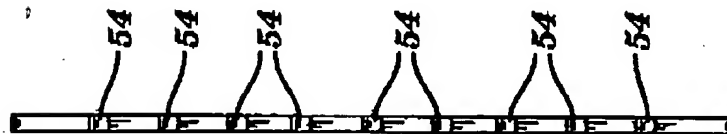


FIG. 4

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608.01(n)

MANUAL OF PATENT EXAMINING PROCEDURE

which is so worded that it, in fact is not, as, for example, it does not include every limitation of the claim on which it depends, will be required to be *canceled* as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. Where a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim or rewriting of such improper dependent claim in independent form. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992) (A claim determined to be an improper dependent claim should be treated as a formal matter, in that the claim should be objected to and applicant should be required to cancel the claim (or replace the improper dependent claim with an independent claim) rather than treated by a rejection of the claim under 35 U.S.C. 112, fourth paragraph.). The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

Note, that although 37 CFR 1.75(c) requires the dependent claim to further limit a preceding claim, this rule does not apply to product-by-process claims.

Claims which are in improper dependent form for failing to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c) by using form paragraph 7.36.

§ 7.36 Objection, 37 CFR 1.75(c), Improper Dependent Claim

Claim [1] objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. [2].

Examiner Note:

1. In bracket 2, insert an explanation of what is in the claim and why it does not constitute a further limitation.
2. Note *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) for situations where a method claim is considered to be properly dependent upon a parent apparatus claim and should not be objected to or rejected under 35 U.S.C. 112, fourth paragraph. See also MPEP § 608.01(n), "Infringement Test" for dependent claims. The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim.

III. INFRINGEMENT TEST

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

The fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction.

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be

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PARTS, FORM, AND CONTENT OF APPLICATION

608.01(n)

a proper dependent claim **>since it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim<.

IV. CLAIM FORM AND ARRANGEMENT

A singular dependent claim 2 could read as follows:

2. The product of claim 1 in which

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a *dependent* claim should not be separated therefrom by any claim which does not also depend from said "dependent claim." It should be kept in mind that a dependent claim may refer back to any preceding independent claim. These are the only restrictions with respect to the sequence of claims and, in general, applicant's sequence should not be changed. See MPEP § 608.01(j). Applicant may be so advised by using form paragraph 6.18.

¶ 6.18 Series of Singular Dependent Claims

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

During prosecution, the order of claims may change and be in conflict with the requirement that dependent claims refer to a preceding claim. Accordingly, the numbering of dependent claims and the numbers of preceding claims referred to in dependent claims should be carefully checked when claims are renumbered upon allowance.

V. REJECTION AND OBJECTION

If the base claim has been canceled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete. If the base claim is rejected, the dependent claim should be objected to rather than rejected, if it is otherwise allowable.

Form paragraph 7.43 can be used to state the objection.

¶ 7.43 Objection to Claims, Allowable Subject Matter

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

608.01(o) Basis for Claim Terminology in Description [R-2]

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the application should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification. *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75. MPEP § 608.01(i) and § 1302.01. >Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner's amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). If the examiner determines that the claims presented late in prosecution do not

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